

Application No.: 10/540,867

REMARKS

I. Introduction

In response to the Office Action dated August 20, 2009, Applicants have incorporated the limitations of claim 4 into independent claims 2, 11 and 14. Claim 4 has been cancelled, without prejudice. In addition, claims 15 and 18 have been amended to correct typographical errors. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Non-statutory Obviousness-type double Patenting Rejection

The Examiner has rejected claims 2-4, 7-8 and 14 under non-statutory obviousness-type double patenting over claims 1, 9-10 and 13 of US Patent No. 7,547,489. The Examiner alleges that the claims are not patentably distinct from each other since they both claim an electrochemical device containing language similar in both sets of claims.

In response, Applicants are filing a Terminal Disclaimer concurrently with this Amendment. As such, Applicants respectfully request that the non-statutory obviousness-type double patenting rejection be withdrawn.

III. The Rejection Of Claims 2-4 And 7-36 Under 35 U.S.C. § 112

Claims 2-4 and 7-36 stand rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. With regard to claim 4, it is alleged that it is unclear how the limitation "insulating

Application No.: 10/540,867

material portion” is related to the “insulating area” of claim 2. The Examiner has interpreted the terms to be synonymous with each other.

In response, Applicants point out that the two terms are distinct. As is shown in Fig. 1, for example, the insulating area of the first current collector sheet is labeled “11x”, whereas the “insulating material” on the side faces of the device is labeled “18a” or “18b” and have different functions. Accordingly, the two terms are not synonymous with each other.

With regards to claims 15 and 18, the Examiner alleges that it is unclear what the term “flame” refers to. It appears that a translation error is present in the claims and specification, as the “flame 106” on page 93 of the specification and Fig. 26 of the drawings was intended to be a “frame” as stated by the Examiner. As such, Applicants have amended the claims to recite “frame”. Accordingly, Applicants respectfully request that the § 112 rejections be withdrawn.

IV. The Objection To the Information Disclosure Statement

The Examiner has objected to the IDS filed on April 3, 2009 for failing to contain a concise explanation of the relevance of the Japanese Office Action issued in JP 2003-091143 (dated January 6, 2009), and for the IDS filed on June 2, 2009 for failing to contain a concise explanation of the relevance of the Japanese Office Action issued in JP 2003-409710 (dated April 2, 2009). In addition, the Examiner alleges that no explanation of relevance or translation of JP 11-505958 has been received.

In response, Applicants note that with regard to JP 11-505958, the patent corresponds to US Patent 5,567,544, which was cited in the July 31, 2008 EPO Search Report. Furthermore, the JP applications JP 2003-091143 and JP 2003-409710 are both corresponding Japanese

Application No.: 10/540,867

applications to the present US application. No English translation of the Office Action was prepared and the Office Action was inadvertently listed on the IDS. If the Examiner would like an English translation, Applicants request that the Examiner contact Applicants representative.

V. The Rejection Of Claims 2-4 and 7-36 Under 35 U.S.C. § 103

Claims 2-4, 7-10 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. (US 2003/0104273) in view of Longhi, Jr. et al. (USP No. 6,923,837); claims 11-13, 30-31, 33 and 35-36 over Lee in view of Longhi and Dudley et al. (US 2002/0197535); claims 14-19, 23 and 25-29 over Lee in view of Longhi and Lyman (USP No. 5,567,544); claims 20-22 over Lee in view of Longhi and further in view of Kawakami et al. (USP No. 6,051,340); and claims 32 and 34 over Lee in view of Longhi and Dudley and further in view of Yamashita et al. (USP No. 6,287,720). As the limitations of claim 4 have been incorporated into independent claims 2, 11 and 14, Applicants will refer to "amended independent claims 2, 11 and 14" in addressing the rejection of claim 4. Applicants respectfully traverse these rejections of the pending claims for at least the following reasons.

Independent claims 2, 11 and 14 each recite, in-part, a first side face which has a first insulating material portion for insulating a first terminal from a second electrode, and a second side face that has a second insulating material portion for insulating a second terminal from a first electrode.

Nowhere in the cited prior art is there any indication of an insulating material portion such as 18a and 18b located at either side face of the device. As can be seen in, for example, Figs. 1-7 of Lee, or in Figs. 7, 9 or 10 of Longhi Jr., there simply is no insulating material portion on either the first or second side faces of the electrode plate assembly. Moreover, the Office Action fails to discuss this feature. In contrast, as indicated above, the present disclosure shows

Application No.: 10/540,867

a first insulating material portion 18a for insulating a first terminal from a second electrode 15b, and a second insulating material portion 18b for insulating a second terminal from a first electrode 15a. As such, it is clear that neither Lee nor Longhi teach or suggest all of the limitations of amended independent claims 2, 11 and 14 of the present disclosure.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. As is clearly shown, Lee and Longhi do not disclose a first side face which has a first insulating material portion for insulating a first terminal from a second electrode, and a second side face that has a second insulating material portion for insulating a second terminal from a first electrode. Accordingly, Applicants submit that Lee and Longhi do not render claims 2, 11 and 14 of the present disclosure obvious and as such, claims 2, 11 and 14 are patentable and allowable over the cited prior art. Accordingly, Applicants respectfully request that the § 103(a) rejection of claims 2, 11 and 14 be withdrawn.

VI. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 2, 11 and 14 are patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

Application No.: 10/540,867

VII. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

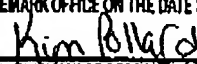

Michael E. Fogarty
Registration No. 36,139


**Please recognize our Customer No. 53080
as our correspondence address.**

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF/NDM:kap
Facsimile: 202.756.8087
Date: November 20, 2009

CERTIFICATION OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY THAT THIS PAPER IS BEING
FACSIMILE TRANSMITTED TO THE PATENT AND
TRADEMARK OFFICE ON THE DATE SHOWN BELOW



TYPE OR PRINT NAME OF PERSON SIGNING CERTIFICATION
 11/20/09
SIGNATURE DATE